REMARKS

Claims 5-68 are pending prior to this Amendment. Claims 5-56 stand withdrawn from consideration. Claims 57-68 are rejected, and are discussed below.

At page 2 of the Office Action, the Examiner refers to the summary data sheet page 8-108, and notes that although the isomers are labeled R and S, it was not possible to tell which is the dextro. For the record, Applicants note that the S isomer is intended to refer to the dextro.

Claims 57-68 stand rejected under 35 USC 102(b), as allegedly being anticipated by Tamura, Houghton, Musch or Cotrel '149. The Examiner argues that the references disclose zopiclone and compositions thereof, and that both the d and l forms will be present as components of the prior art racemic mixture. The Examiner concludes that the d compound is old, and notes that patenting of an old mixture requires some purity limitation.

Applicants respectfully traverse this rejection.

First, it is noted that claims 60-62 and 68 have been cancelled without prejudice or disclaimer, as discussed further below.

Claims 57-59 are directed to the dextrorotary or (+) isomer of zopiclone. The original claim language "*The* dextrorotary isomer" is intended to distinguish this isomer from the racemate and from the levorotary or (-) isomer. Kindly refer to the specification at pages 1-3. As discussed therein, the present inventor unexpectedly discovered that the dextrorotary isomer of zopiclone possesses desirable properties not found in either the racemate or the levorotary isomer. Prior to the present invention, the prior art did not isolate or synthesize the zopiclone enantiomers in pure or substantially pure forms, much less recognize or appreciate the

unexpected superiority of the dextrorotary isomer. At pages 1-3 and thereafter, the specification uses the term "the dextrorotary isomer" as distinguishing it from both the racemate and the levorotary or (-) isomer. The specification clearly describes that the dextrorotary isomer of zopiclone may be prepared from the corresponding racemate according to the usual methods, such as chiral-phase chromatography, resolution of an optically active salt, stereoselective enzymatic catalysis by means of an appropriate microrganism, or asymmetric synthesis. See page 3, lines 5-10. It would be readily apparent to one of ordinary skill in the art that the term "the dextrorotary isomer" of zopiclone, as used in accordance with the present invention, is intended to refer to the product of these separation or asymmetric synthesis techniques, which provide the desired isomer in at least substantially optically pure form. Thus, while the original claim language is submitted to have conveyed this intent when interpreted in light of the specification, for clarification each of compound claims 57-59 has been amended so as to recite the "substantially optically pure" dextrorotary isomer. Similarly, each of the pending pharmaceutical composition claims 63-67 has been amended for clarification in a similar fashion. It will be apparent that in view of the original claim language discussed above, interpreted in light of the underlying disclosure, no scope reduction has been effected by these amendments. Moreover, the amended claim language is considered to have basically the same meaning as the pertinent portion of claim 1 of parent U.S. Patent 6,319,926: "6-(5-chloro-2-pyridyl)-5-[(4-methyl-1-piperazinyl)carbonyloxy]-7-oxo-6,7-dihydro-5H-pyrrolo[3,4-b]pyrazine, or a pharmaceutically acceptable salt thereof, in the form of its dextrorotatory isomer and

essentially free of its levorotatory isomer." New claim 69 has been added, directed to the compound using this alternate claim language appearing in the issued parent claim.

As the Examiner recognizes, the cited art is basically directed to racemic zopiclone. It is respectfully submitted that the original claim language as discussed above, and especially in view of the further clarifying amendments, precludes any basis for concluding that the claimed subject matter lacks novelty over the prior art racemic mixture. Moreover, to the extent an obviousness rejection may be subsumed within the stated grounds, the same record evidence which supported the patentability of the method of using the dextrorotary zopiclone isomer in parent application 09/124,651, now issued as U.S. Patent 6,319,926, also provides a basis for patentability of the (+) zopliclone isomer and pharmaceutical compositions containing it.

Accordingly, reconsideration and withdrawal of the rejection under section 102(b) is respectfully requested.

Claims 57-62, 64-65 and 67-68 stand rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Six paragraphs are set forth on page 3 of the Office Action, in support of this rejection.

This rejection is respectfully traversed.

Clarifying corrections to the claim language, without scope reduction as would be apparent, address the Examiner's statements in the first three paragraphs. Regarding paragraph 4, for purposes of advancing prosecution, the claim term "methylene-bis-β-oxynaphthoates" has been cancelled from the relevant dependent claims, without prejudice or disclaimer. Regarding paragraph 5, Applicants have cancelled claims 60-62, without prejudice or disclaimer, for

purposes of advancing prosecution. Finally, in paragraph 6, the Examiner questions the term "additive" in dependent claim 67. While the term "adjuvant" should have been used in the original claim, as the Examiner notes on page 4 of the Office Action, Applicants have simplified the composition claims by amending claim 67 so as to define the carrier as a diluent, and cancelling claim 68. Besides the diluent as carrier, the specification at page 5 makes abundantly clear that the inventive composition in its various forms as solid and liquid compositions for oral administration, can contain other substances as necessary or desirable. Moreover, the specification at pages 5-6 makes abundantly clear that the inventive composition in its various forms as compositions for parenteral administration, can contain solvents, adjuvants and other substances as necessary or desirable.

In view of the foregoing, reconsideration and withdrawal of the indefiniteness rejection is respectfully requested.

At page 4 of the Office Action, dependent claims 67-68 stand rejected under 35 USC 112, first paragraph, as allegedly violating the written description requirement. Paragraphs A, B and C are set forth in support of this rejection. In view of the amendment to claim 67 and cancellation of claim 68, the stated grounds are considered to be moot, and withdrawal of the rejection is respectfully requested.

At page 4 of the Office Action, dependent claims 59, 62 and 65 stand rejected under 35 USC 112, first paragraph, as allegedly violating the written description requirement. The rejection is based on the use of the term "methylene-bis-β-oxynaphthoates" in these claims. In

view of the claim amendments discussed above in which this term has been deleted, the stated grounds are considered to be moot, and withdrawal of the rejection is respectfully requested.

Although claims 5-56 stand withdrawn from consideration in view of the prior restriction requirement, should the Examiner find the examined claims to be allowable, rejoinder of the non-elected claims is respectfully requested upon indication of allowability of the elected compound claims, pursuant to MPEP 806.05(i). In this regard, it is noted that where the compound claims have been found novel and unobvious, no additional search or examination burden should be presented vis-à-vis the non-elected claims. If the Examiner is inclined to permit rejoinder, the undersigned could readily submit a conforming amendment to claims 5-56, bringing their language into conformance with the amended language of the claims set forth in this Amendment.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

In addition to the Petition for three-month extension of time filed concurrently herewith, Applicants hereby petition for any other extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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APPENDIX SHOWING CHANGES IN REDLINED FORM

Please amend this application as follows:

IN THE CLAIMS:

Please cancel claims 60-62 and 68 without prejudice or disclaimer.

Please amend the following claims as shown below:

57. (Amended) The substantially optically pure dextrorotatory isomer of 6-(5-chloro-2-pyridyl)-5-[(4-methyl-1-piperazinyl)-carbonyloxy]-7-oxo-6,7-dihydro-5H-pyrrolo[3 ,4-b]pyrazine, ~~and~~ or a pharmaceutically acceptable salts thereof.

58. (Amended) ~~-~~The substantially optically pure dextrorotatory isomer according to claim 57, wherein the pharmaceutically acceptable salt~~s are salts of~~ is a salt of a mineral acids, or a substitute~~dion~~ derivatives thereof, selected from the group consisting of ~~chlorohydrates~~hydrochlorides, sulfates, nitrates, and phosphates.

59. (Amended) The substantially optically pure dextrorotatory isomer according to claim 57, wherein the pharmaceutically acceptable salts is a salt of an~~are salts of~~ organic acids, or a substitute~~dion~~ derivatives thereof, selected from the group consisting of acetates, propionates, succinates, benzoates, fumarates, tartrates, theophyllineacetates, salicylates, and phenolphthalinates~~, and methylene bis β oxynaphthoates~~.

63. (Amended) A pharmaceutical composition comprising an effective amount of the substantially optically pure dextrorotatory isomer of 6-(5-chloro-2-pyridyl)-5-[(4-methyl-1-piperazinyl)-carbonyloxy]-7-oxo-6,7-dihydro-5H-pyrrolo[3 ,4-b]pyrazine, or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier.

64. (Amended) The pharmaceutical composition according to claim 63, wherein the pharmaceutically acceptable salt is a salt of a mineral acid, or a substituted~~ion~~ derivatives thereof, selected from the group consisting of ~~chlorohydrates~~hydrochlorides, sulfates, nitrates, and phosphates.

65. (Amended) The pharmaceutical composition according to claim 63, wherein the pharmaceutically acceptable salt is a salt of an organic acid, or a substituted~~ion~~ derivatives thereof, selected from the group consisting of acetates, propionates, succinates, benzoates, fumarates, tartrates, theophyllineacetates, salicylates, and phenolphthalinates~~, and methylene-bis-β-oxynaphthoates~~.

66. (Amended) The pharmaceutical composition according to claim 63, wherein the therapeutically effective amount of the substantially optically pure dextrorotatory isomer of 6-(5-chloro-2-pyridyl)-5-[(4-methyl-1-piperazinyl)-carbonyloxy]-7-oxo-6,7-dihydro-5H-pyrrolo[3 ,4-b]pyrazine, or a pharmaceutically acceptable salt thereof, is from about 2.5 mg to about 15 mg.

67. (Amended) The pharmaceutical composition according to claim 63, wherein the pharmaceutically acceptable carrier comprises a diluent~~, lubricant, sweetener, aromatic, or additive, or combinations thereof~~.

Please add the following additional claim:

--69. (New) 6-(5-chloro-2-pyridyl)-5-[(4-methyl-1-piperazinyl)carbonyloxy]-7-oxo-6,7-dihydro-5H-pyrrolo[3,4-b]pyrazine, or a pharmaceutically acceptable salt thereof, in the form of its dextrorotatory isomer and essentially free of its levorotatory isomer.--